

### REMARKS/ARGUMENTS

Claims 1-15, 17-22, and 27-33 are pending in this application. Claims 1, 9, 13, 19, 27 and 33 are independent claims. Claims 1, 9, 13, 19 and 27 have been currently amended.

#### Claim Rejections – 35 USC § 102

Claims 1, 9, 13 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Moshfeghi (“Moshfeghi”, U.S. Patent No. 6,476,833). Claim 33 was rejected under 35 U.S.C. § 102(e) as being anticipated by Humpleman et al. (“Humpleman”, U.S. Patent No. 6,288,716). Applicant respectfully traverses these rejections. However, Claims 1, 9, 13 and 19 have been currently amended.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claims 1, 9, 13 and 19, as amended, each recite an element of “comparing the user interface data with a user interface template, the user interface template including one or more representations” (emphasis added). The amendment is supported, for example, in lines 9-21, page 7 of Specification and FIG. 5. In rejecting independent Claims 1, 9, 13 and 19, the Patent Office has relied on col. 3, lines 10-25 for teaching the foregoing indicated element (Office Action, line 2, page 3; lines 10-12, page 4). However, nowhere in col. 3, lines 10-25 of Moshfeghi was “the user interface template including one or more representations” as claimed in Claims 1, 9, 13 and 19 suggested, disclosed, or suggested. Thus, the rejection should be withdrawn, and Claims 1, 9, 13 and 19 should be allowed.

In rejecting Claim 33, the Patent Office has asserted that “[i]t is inherent in Humpleman’s system that a music player user interface is cached in temporary

Internet memory and when selecting a song by the user, playing the selected song automatically without waiting for the music player to load (from the temporary Internet memory)” (emphasis added) (Office Action, page 3). Applicant respectfully disagrees.

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added). In the present application, the Patent Office has failed to establish that in Humpleman’s system it is *necessary* to play “the selected song automatically without waiting for the music player to load” as claimed in Claim 33 (emphasis added), because it is *possible* in Humpleman’s system to play the selected song after waiting for the music player to load.

At least based on the foregoing reason, the rejection of Claim 33 should be withdrawn, and Claim 33 should be allowed.

#### Claim Rejections – 35 USC § 103(a)

Claims 1-5, 8-15, 17-22, and 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Moshfeghi. Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman in view of Moshfeghi and further in view of Cragun et al. (“Cragun”, U.S. Patent No. 5,973,683. Applicant respectfully traverses these rejections.

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Independent Claims 1, 9, 13, 19, and 27, as amended, each recite an element of "comparing the user interface data with a user interface template, the user interface template including one or more representations" (emphasis added). As discussed in the foregoing *Claim Rejections – 35 USC § 102* section, Moshfeghi fails to teach, disclose, or suggest this element. Furthermore, as admitted by the Patent Office, Humpleman also fails to teach this element (Office Action, lines 10-11, page 4). Thus, independent Claims 1, 9, 13, 19, and 27 are nonobvious over Humpleman and Moshfeghi and are therefore allowable.

Claims 2-8 and 30 depend from Claim 1 and are therefore nonobvious due to their dependence upon Claim 1. Claims 10-12 and 31 depend from Claim 9 and are therefore nonobvious due to their dependence upon Claim 9. Claims 14-15 depend from Claim 13 and are therefore nonobvious due to their dependence upon Claim 13. Claims 17-18, 20-22 and 32 depend from Claim 19 and are therefore nonobvious due to their dependence upon Claim 19. Claims 28-29 depend from Claim 27 and are therefore nonobvious due to their dependence upon Claim 27. Thus, the rejection should be withdrawn, and Claims 2-8, 10-12, 14-15, 17-18, 20-22 and 28-32 should be allowed.

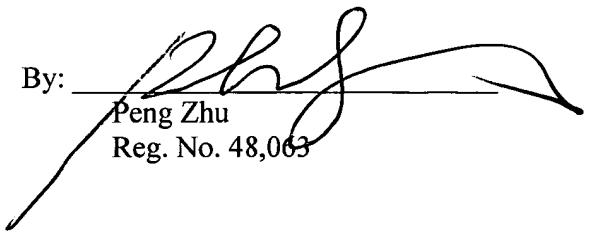
#### CONCLUSION

In light of the foregoing, Applicant respectfully requests that a timely Notice of Allowance be issued in the case.

Respectfully submitted on behalf of  
Gateway, Inc.,

Dated: March 31, 2004

By: \_\_\_\_\_

  
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